UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,338	01/26/2001	Neil Fishman	13768.158	6789

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WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER
SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 August 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>26 January 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant has amended claims 4, 6, 9, 11, 15, 16, 21, 23, 26, 28 and 32.
Claims 1-35 are now pending.

Claim Objections

1.   The proposed correction to claims 4, 6, 9, 11, 15, 16, 21, 23, 26, 28 and 32 filed on

August 27, 2004 has been accepted. The objection is therefore withdrawn.

Response to Arguments

2.   Applicant's arguments, see pages 13-15, filed 8/27/04 with respect to the rejection(s) of

claim(s) 1, 10, 20 and 27 under 35 U.S.C. 102(b) have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn.   However, upon further consideration, a new

ground(s) of rejection is made in view of newly found prior art reference(s).

As discussed in the interview held on August 4, 2004 with the Applicants' attorney, the

Examiner acknowledges the referenced prior art on record, *Verkler et al* (USPN 5,850,517), fails

to anticipate every aspect of the applicants' claimed invention. In particular, *Verkler et al* fail to

teach the customization of content based on the operating characteristic of a mobile client. It is

therefore the Examiner's position to withdraw the previous rejection in light of the new ground

of rejection based on a newly found prior art reference, *Kikinis* (USPN 6,553,410).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1, 4-8, 10, 11, 14-28 and 31-35** are rejected under 35 U.S.C. 102(e) as being

anticipated by *Kikinis* (USPN 6,553,410).

        a.   **Per claim 1,** *Kikinis* teaches a computerized system that includes a content server,

a mobile gateway, and a first and a second mobile client, the first and second mobile clients

differing from each other in at least one operating characteristic, wherein the mobile gateway

receives content that is addressed to the first and second mobile clients from the content server, a

method of customizing the content based on at least one operating characteristic of each mobile

client, wherein the customizing avoids further processing at the content server, the method

comprising a mobile gateway performing the acts of:

- assigning a first transform to the first mobile client and assigning a second transform to the second mobile client, the first and second transforms specifically considering one or more operating characteristics of the first and second mobile clients (**col.11 lines 12-48, col.13 lines 35-66 and col.15 lines 1-65; specific translations and processes are performed on content prior to transmission to**

the specific user devices, wherein the transposing of data performed
according to pre-stored characteristics of the users' devices);

- receiving content from the content server (**Figures 1-5, col.13 lines 35-66 and
  col.15 lines 1-65; content is received from content/web/proxy server**);

- altering the content according to the first and second transforms so that the
  content is compatible with the one or more operating characteristics of the first
  and second mobile clients, the altered content comprising a first transformed
  content and a second transformed content (**col.11 lines 12-48, col.12 lines 11-27,
  col.13 lines 35-66, col.15 line 1-col.16 line 48 and col.28 lines 30-63; content is
  transposed according to the specific characteristics of each hand-held unit**);

- establishing a communication link between the mobile gateway and the first and
  second mobile clients (**Figures 1-4, col.6 line 1-col.8 line 28; proxy server
  implementing the InterBrowser program achieves the function of the mobile
  gateway, wherein a communication link if formed with the hand-held mobile
  units**); and

- sending the first transformed content to the first mobile client and sending the
  second transformed content to the second mobile client (**col.8 lines 3-59, col.11
  lines 22-48, col.15 lines 1-65 and col.25 lines 17-39; content is transmitted to
  the respective mobile unit based upon the user ID of the device and its pre-
  stored operating capabilities**).

b.   **Claims 10, 17, 20, 27 and 33** contain limitations substantially equivalent to the
limitations of claim 1 and are therefore rejected under the same basis.

c.   **Per claim 4,** *Kikinis* teaches the method as recited in claim 1 wherein at least one
of the mobile clients is one of a telephone, a pager, a personal digital assistant, or a cascaded
mobile gateway (**col.5 lines 36-49 and col.8 lines 47-59; embodiments provide support to
various types of mobile units, including telephones, pagers, and PDAs**).

d.   **Claims 15 and 21** are substantially equivalent to claim 4 and are therefore
rejected under the same basis.

e.   **Per claim 5,** *Kikinis* teaches the method as recited in claim 1 wherein the first

transformed content comprises a notification that additional content is available at the content

server, the method further comprising the acts of:

- receiving a request for the additional content from the first mobile client
  (**col.3 line 19-col.4 line 4; mobile client requests additional content,
  e.g. refreshing current and stored pre-fetched web pages**),

- retrieving the additional content from the content server (**col.3 line 19-
  col.4 line 15; additional content is retrieved from server**);

- altering the additional content according to the first transform so that the
  content is compatible with the one or more operating characteristics of the
  first mobile client, the act of altering producing a first transformed
  additional content (**col.2 line 63-col.3 line 7 and col.4 lines 5-25; content
  is translated and reduced according to characteristics supplied by the
  mobile unit for compatibility prior to transmission**); and

- sending the first transformed additional content to the first mobile client
  (**Abstract and col.2 line 63-col.4 line 25; upon transposing of the
  content, content is then transmitted to the corresponding requesting
  mobile unit**).

f.   **Claims 14, 22 and 31** are substantially equivalent to claim 5 and are therefore

rejected under the same basis.

g.   **Per claim 6,** *Kikinis* teaches the method as recited in claim 1 wherein the one or

more operating characteristics considered by the first and second transforms include at least one

of the first and second mobile client's software, processor, memory, display, or communication

link (**col. 2 line 63-col.3 line 7, col.8 lines 15-46, col.15 line 32-col.16 line 48 and col.25 line

41-col.26 line 18; mobile unit's characteristics are inclusive of CPU type, power, display

size, type and resolution, sound capability, etc—furthermore, the user can modify a

template to add additional characteristics or preferences for tailoring the content**).

h.   **Claims 11, 23 and 28** are substantially equivalent to claim 6 and are therefore rejected under the same basis.

i.   **Per claim 7,** *Kikinis* teaches the method as recited in claim 1 wherein the computerized system includes a third mobile client, the method further comprising the acts of:

- assigning the first transform to the third mobile client, the first transform specifically considering one or more operating characteristics of the third mobile client (**col. 2 line 63-col.3 line 7 and col.25 line 41-col.26 line 50; utilizing templates allows for common mobile devices to receive the same converted data, thus data transposed for a first device may also be sent to another device if it has similar operating characteristics and/or template**); and

- sending the first transformed content to the third mobile client (**col.25 line 41-col.26 line 50; content is transmitted to the corresponding requesting device after content is transposed according to the template and/or operating characteristics for that particular device**).

j.   **Claims 19, 24 and 35** are substantially equivalent to claim 7 and are therefore rejected under the same basis.

k.   **Per claim 8,** *Kikinis* teaches the method as recited in claim 1 wherein the content received from the content server is addressed to a list containing the first and second mobile clients, the method further comprising the act of addressing the content specifically to the first mobile client and to the second mobile client as defined in the list (**Figure 5, col.13 line 44-col.14 line 62, col.15 line 19-col.16 line 12 and col.27 line 9-col.28 line 7; content may be transmitted to mobile devices per requests, which are directed by a traffic cop mirror system—thus an address list of mobile users is implied within the system**).

l.   **Claims 18, 25 and 34** are substantially equivalent to claim 8 and are therefore rejected under the same basis.

m.   **Per claim 9,** *Kikinis* teaches the method as recited in claim 1 wherein the content

comprises one of email, calendar, contact, task, Web, notification, financial, configuration, and

sports content **(col.8 line 47-col.9 line 65 and col.10 lines 21-col.11 line 48; content comprises**

email, scheduling appointments and tasks, financial, web browsing, etc).

n.   **Claims 16 and 27** are substantially equivalent to claim 9 and are therefore

rejected under the same basis.

o.   **Claim 32** is substantially equivalent to claims 4 and 9 and is therefore rejected

under the same basis.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 2, 3, 12, 13, 29 and 30** rejected under 35 U.S.C. 103(a) as being unpatentable

over *Kikinis* in view of *Verkler et al* (USPN 5,850,517).

a.   **Per claim 2,** *Kikinis* teaches the method of claim 1 as applied above, yet fails to

explicitly teach the method as recited in claim 1 further comprising the act of at least one of the

transforms encrypting the content. However, *Verkler et al* teach a message gateway allowing

components to be self-configuring and applying system security by implementing user password

encryption **(col.7 lines 50-63)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Kikinis* and *Verkler et al* for the purpose of developing a computing environment with encryption to protect the integrity of the content specific to that individual user because it would permit and insure secure transactions between the client devices and the content server via the gateway.

b.   **Claims 12 and 29** are substantially equivalent to claim 2 and are therefore rejected under the same basis.

c.   **Per claim 3,** *Kikinis* teaches the method of claim 1 as applied above, yet fails to explicitly teach the method as recited in claim 1 further comprising the act of at least one of the transforms compressing the content. However, *Verkler et al* teach data compression of the content during data transmission (**col.8 lines 17-19**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Kikinis* and *Verkler et al* for the purpose of increasing the computing system's throughput of content specific to mobile client's because it would increase the computing system's performance and efficiency when transmitting and transposing various types of content.

d.   **Claims 13 and 30** are substantially equivalent to claim 3 and are therefore rejected under the same basis.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

      a.   *Reisman* (USPN 6,125,388) discloses a system for transporting information objects between a user station and multiple remote sources based upon user modifiable objects manifest stored in the user station.

      b.   *Himmel* (USPN 6,167,441) discloses a customization of web pages based on requester type.

      c.   *Payne et al* (USPN 6,021,433) disclose a system and method for transmission of data.

      d.   *Kloba et al* (USPN 6,421,717) disclose a system, method and computer program product for customizing channels, content, and data for mobile devices.

      e.   *Kloba et al* (USPN 6,553,412) disclose a system, method and computer program product for web content aggregation and development, and web content delivery to clients.

      f.   *Christfort et al* (US 20020078168) disclose developing applications online.

      g.   *Christfort et al* (US 20020120684) disclose customizing content provided by a service.

      h.   *Wu* (US 20020087630) disclose enhanced information and presence service.

      i.   *Kim et al* (US 20020052925) disclose a method and apparatus for information delivery on the Internet.

      j.   *Rouse et al* (US 20020103908) disclose a system and method for providing customizable options on a wireless device.

      k.   *Hwang et al* (US 20020107985) disclose providing data services via wireless mobile devices.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The

examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER